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**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA**

WALKER & ZANGER, INC.,

Plaintiff,

vs.

**PARAGON INDUSTRIES, d/b/a
BEDROSIANS,**

Defendants

Case No.: C04-1946 VRW

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT**

Date: March 2, 2006
Time: 2:00 p.m.
Place: Courtroom 6, 17th Fl.
Before: Hon. Vaughn R. Walker

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Bellissima™




Tilecrest® COLLECTION

Bellissima™ Glazed Ceramic Tile

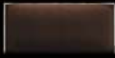
Craftsmanship, Elegance, and Timeless Beauty!



6"x6" Field Tile




3"x6" Arlequin Field Tile




3"x6" Field Tile


Listellos




Venus (4"x12")




Karena (2"x12")




Vesta (1"x12")




Twist (1"x12")



Helena Twist (4"x12")

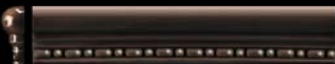


Flor de Lis (3"x12")

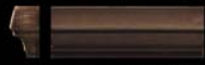


Minerva (2"x12")


Trims



Chair Rail (2.5"x12") - (Shown with Corner)



Sink Cap (2.5"x6")
(Shown with Corner)




Quarter Round (1"x6")
(Corner available but not shown)


Note: 6"x6" Surface Bullnose and 6"x6" Surface Bullnose Corners are available but not shown

Note: Gloss finish tiles should not be used on Kitchen Counter tops - May be used on backsplashes


Olive Leaf



6"x6" Field Tile




3"x6" Arlequin Field Tile




3"x6" Field Tile

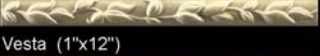
Listellos




Venus (4"x12")




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Twist (1"x12")



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Note: Gloss finish tiles should not be used on Kitchen Counter tops - May be used on backsplashes

1 TO THE PARTIES AND THEIR ATTORNEYS OF RECORD:

2 PLEASE TAKE NOTICE that Paragon Industries, Inc., d/b/a Bedrosians ("Defendant" or
3 "Paragon") hereby moves the United States District Court for the Northern District of California
4 for Summary Judgment as against Walker & Zanger, Inc. (hereinafter "Plaintiff"). This Motion
5 is noticed to be heard before the Honorable Vaughan R. Walker on March 3, 2006 at 9:30 a.m. in
6 Courtroom 6 of the U.S. District Courthouse, 450 Golden Gate Ave., San Francisco, California.

7 **I. RELIEF REQUESTED AND INTRODUCTION**

8 For the reasons set out below, Defendant requests that the Court dismiss with prejudice
9 Plaintiff's claims for (1) violation of section 43(a) of the Lanham Act through unfair
10 competition and false advertising by misappropriating plaintiff's trade dress and making false
11 claims about plaintiff's products; (2) violation of section 43(a) of the Lanham Act by infringing
12 plaintiff's trade dress and thereby confusing consumers as to the origin of defendant's goods; (3)
13 violation of section 43(a) of the Lanham Act by falsely claiming that plaintiff's and defendant's
14 goods have the same origin; (4) infringement of plaintiff's copyrights in its tiles; (5) violation of
15 the California unfair competition law, Cal Bus & Prof Code § 17200; and (6) false advertising
16 under California statutory and common law.

17 Regarding Plaintiff's unfair competition claims, in *Wal-Mart Stores, Inc. v. Samara*
18 *Brothers*, the United States Supreme Court recognized that

19 In the case of product design . . . [c]onsumers are aware of the reality that, almost
20 invariably, even the most unusual of product designs--such as a cocktail shaker
shaped like a penguin--is intended not to identify the source, but to render the
product itself more useful or more appealing.

21 529 U.S. 205, 213 (2000). Thus, the Court eliminated the notion that a product's design can be
22 inherently distinctive for fear that competition would be deterred by even the mere "plausible
23 threat of successful suit" *Id.* at 214.

24 The instant matter, involving the alleged "inherently distinctive" (*Complaint*, ¶¶ 8-11)
25 trade dress of five tile designs, two tile lines and an unknown number of unidentified and
26 undisclosed tile displays, has proved to be precisely the sort of "anti-competitive strike suit" that
27 the Supreme Court sought to eliminate in *Wal-Mart*. *Id.*

1 Plaintiff has not provided any evidence that its tile designs are nonfunctional, that they
 2 have obtained secondary meaning, or that there is a likelihood of source or affiliation confusion
 3 between the parties' tiles. In fact, Plaintiff has produced no evidence whatsoever for two of its
 4 tile designs, and its survey evidence on secondary meaning and likelihood of confusion, if not
 5 inadmissible, would prove Defendant's position as a matter of law.

6 Plaintiff has not provided evidence that there is a likelihood of confusion between either
 7 of Plaintiff's two allegedly infringed tile lines and Defendant's single tile line, either. Similarly,
 8 Plaintiff has provided no evidence whatsoever to prove that its tile *displays* are nonfunctional,
 9 have obtained secondary meaning, or are likely to be confused with any of Defendant's tile
 10 displays. Indeed, Plaintiff has not identified any evidence whatsoever supporting the notion that
 11 Defendant's tile displays are anything like Plaintiff's tile displays.

12 Rather, Plaintiff's evidence proves that its tiles, tile lines and tile displays are functional
 13 or simply not copied by Defendant. Its own surveys prove that its tile designs have *no* secondary
 14 meaning and that there is *no* likelihood of confusion. And its own witnesses, employees and
 15 officers attest to the fact that neither they nor the general public were or would be confused and
 16 that they have no evidence to support any of Plaintiff's claims.

17 Lastly, judgment also must be entered in favor of Defendant on Plaintiff's copyright
 18 claim because, other than statutory presumptions that will be rebutted, Plaintiff has no evidence
 19 that its tile designs are original. Judgment against Plaintiff also must be entered because Plaintiff
 20 itself appropriated verbatim the designs for its two copyrighted tiles from the public domain and
 21 there is no evidence that Plaintiff added any original contributions to those designs. Separate
 22 discussions of each of these issues are set out below.

23 II. STATEMENT FACTS

24 **Plaintiff's Tiles:** Plaintiff markets and distributes ceramic and other tiles that are
 25 produced to its specifications by other manufacturers. *Complaint*, ¶ 7; *Declaration of IBraun*
 26 *Degenshein* ("IBD"), ¶2, **Exh. A: Petrocelli Deposition Transcript**¹, 12:16-25, 13:1-4, 20-25;

27
 28 ¹ For the sake of brevity, deposition transcripts will be referred to simply by the witness' last name, followed by

14:1-3, 41:8-10. Plaintiff's tiles are sold in its own showrooms, through independent tile dealers and distributors. *Complaint*, ¶ 12; **Exhs. A** (*Petrocelli*, 12:16-25, 17:1-10, 14:17-25) and **C** (*Bastone*, 8:15-21); **IBD Exh. D** (*Pltf's Resp. to Interrog. Nos. 15-16*).

Plaintiff markets its tiles in thematic lines. For example, Plaintiff's "Avignon" line has a "French Provençal" theme and its "Newport" line has a "whimsical" theme with "seashore-related designs and colors." *Complaint*, ¶18.; **IBD Exh. D** (*Pltf's Resp. to Interrog. No. 16*). Four out of at least sixteen Avignon tile designs and one of at least eleven tile designs in its Newport line are pertinent: the Romanesque, Fleur de Lis, Treillage and Perle moldings from the former, and the Westport Molding from the latter. The five tiles at issue were made for Plaintiff in Mexico and have "Walker Zanger" stamped on the back of each. **IBD**, ¶3, **Exh. B** (*Becker*, 33:3-10, 121: 23-25, 122: 1-4).

Plaintiff began promoting the Avignon and Newport lines in August, 1999. *Complaint*, ¶11. It markets its tiles through its showrooms, authorized dealers, catalogs, cross-promotions with other companies, design centers², over the Internet and in trade and general circulation publications that target affluent end users. *Complaint*, ¶ 12; **IBD**, 2, 4, 5; **Exhs. A** (*Petrocelli*, 103:17-25, 104:1-12, 109:12-25); **C** (*Bastone*, 8:15-21, 21:16-17, 23:3-5); and **D** (*Resp. to Interrog Resp. No. 15*). It no longer markets its products at major trade events like the annual "Surfaces" show in Las Vegas. *Id.*, ¶2, **Exh. A** (*Petrocelli*, 103:17-25, 104:1-12, 109:12-25).

Plaintiff first learned of Paragon's "Bellissima" line of tiles at the "Surfaces" trade show in Las Vegas in January, 2004. On February 10, 2004, Plaintiff filed expedited applications to register the copyrights for all five tile designs. **IBD**, ¶6, **Exh. E** (*Copyright Applications*).

page and line references. The excerpts are attached to the Declaration of I Braun Degenshein as exhibits. The "IBD **Exh. ____**" reference before the witnesses' designation refers to the exhibit tab in the Degenshein Declaration. All other exhibits to the Degenshein Declaration will be referred to as "IBD **Exh. ____**."

² A "design center" is either a showroom owned by the builder or one that is independently owned that contracts with the builder" **IBD Decl.**, ¶14, **Exh. M** (*Wright*, 12:23-13:1). The contract "with new home builders to assist their clients in making finish selections for their new homes." *Id.*, ¶8, **Exh. G** (*Reed*, 11:18-20). Design centers often require credentials to get in, and generally are not open to the public or walk in traffic. *Id.*, ¶2, **Exh. A** (*Petrocelli*, 19:3-9).

1 However, the Copyright Office refused to register the Perle, Fleur de Lis, and Westport Molding
 2 designs because they lacked the requisite originality, i.e., they were based upon common, public
 3 domain designs. *Id.*

4 Apparently unaware of the historical precedence for the “Romanesque Molding” and
 5 “Treilage Molding” designs, the Copyright Office issued registrations for those tiles. The former
 6 received Registration number VA 1-225-300 and the latter received Registration Number VA 1-
 7 225-301. *Complaint*, **Exh. B**. Both certificates state a first date of publication of August 3,
 8 1999. *Id.* The certificates indicate that the Romanesque Molding was derived from “Old Wood
 9 Carvings” and that the Treilage Molding was derived from an “Old Frieze.” *Id.*

10 **Paragon’s Tiles:** Paragon imports, distributes, and sells tiles designed for home décor.
 11 Its tiles are marketed to customers of far more modest means than Plaintiff’s targeted customer.
 12 **IBD, ¶7, Exh. F** (*Bedrosian*, 92:17-25, 231:4-6). Its tiles are sold at a significantly lower price
 13 point as well. **IBD, ¶10, Exh. I** (*Leiferman*, 30).

14 Paragon sells its tiles through its own showrooms and through design centers. **IBD, ¶9,**
 15 **Exh. H** (*Movesian*, 15:21-25; 16, 17:2-8). Its tiles are manufactured either by itself or by others
 16 and sold under Paragon’s trademarks. **IBD, ¶7, Exh. F** (*Bedrosian*, 70:9-25, 71:1, 76:3-12,
 17 81:21-24; 82:6-9). Paragon also distributes and sells other manufacturers’ tiles under those
 18 manufacturers’ respective trademarks. **IBD, ¶¶ 7, 9, Exhs. F** (*Bedrosian*, 143:10-13); and **H**
 19 (*Movesian*, 22:1-4).

20 Paragon’s marketing budget is a small fraction of Plaintiff’s as Paragon has a completely
 21 different approach to advertising. Paragon does not market its individual tiles and tile lines in
 22 display advertisements of any kind, anywhere. *Movsesian Decl.*, ¶ 2. Instead, a completely
 23 insignificant amount is directed to generic advertising that touts showroom and warehouse
 24 locations with generic categories of products available. **IBD Decl.**, ¶18, **Exh. Q** (*Dfnts’ Resp. to*
 25 *Interrogatory No. 9* at 15:3-9). It also dedicates a small portion of its budget on its Internet web
 26 site and at to industry trade shows like “Surfaces.” **IBD, ¶18, Exh. Q** (*Dfnts’ Resp. to*
 27 *Interrogatory No. 9* at 15:3-9). The remainder and largest share of Paragon’s modest budget
 28 goes to direct mailings to “extremely knowledgeable and sophisticated” professionals like

1 architects, designers, and contractors who “can tell the difference between the various
2 manufacturers’ tiles.” *Id.* (*Dfnts’ Resp. to Interrogatory No. 10* at 16:17-20); *see also*, **IBD**, ¶9,
3 **Exh. H** (*Movesian*, 14, 28:9-13, 20-22, 30:6-16, 33:21-25, 34:1-5).

4 All five of Paragon’s tiles are marketed under the “Tilecrest” trademark as part of the
5 “Bellissima” line. **IBD**, ¶7, **Exh. F** (*Bedrosian*, 81:2-10); *Bedrosian Decl.*, **Exh. A** (“*Tilecrest*
6 *Collection: Bellissima*”).

7 Paragon’s tiles are mass manufactured in China using a dry press extrusion process.
8 *Bedrosian Decl.*, ¶4, **Exh. B** (*Methods of Manufacture*). The backs of each tile are stamped with
9 Paragon’s unique, stylized “B” logo. *Id.*, ¶3. The parties’ different manufacturing methods result
10 in substantial dissimilarities are readily discernable by industry professionals like interior
11 designers. **IBD**, ¶3, 7-8, 10, **Exhs. B** (*Becker*, 141:25 to 142:9), **F** (*Bedrosian*, 231:7-14, 232:13-
12 14 & 20-25, 233:1-4), **G** (*Reed*, 35:10-24, 83:13-25, 84:1-2 & 21-25, 85:11-21) and **I**
13 (*Leiferman*, 29, 21-25, 66:6-17). The differences are apparent to Plaintiff’s high-income target
14 consumers as well. *Id.*, **Exh. I** (*Leiferman*, 144:23-25, 145:1-19).

15 Paragon began planning the Bellissima line in 2002. **IBD**, ¶7, **Exh. F** (*Bedrosian*, 91:19-
16 21). During this process, hundreds of designs were considered, including wallpaper, tiles with
17 glazes, moldings, catalogs and many other manufacturers’ tile designs. *Id.* at 93:21-25, 95:1 &
18 12-25, 96:1 & 8-18, 282:6-21.

19 III. SUMMARY JUDGMENT IS APPROPRIATE

20 Summary judgment must be granted when the evidence of record, viewed in a light most
21 favorable to the nonmoving party, raises no genuine issue of material fact, at which time the
22 mere existence of *some* alleged factual dispute between the parties will not defeat an otherwise
23 properly supported motion for summary judgment. Fed. R. Civ. P. 56(c); *Anderson v. Liberty*
24 *Lobby*, 477 U.S. 242, 247-48 (1986).

25 More importantly, “the plain language of Rule 56(c) mandates the entry of summary
26 judgment . . . against a party who fails to make a showing sufficient to establish the existence of
27 an element essential to that party’s case, *and on which that party will bear the burden of proof at*
28 *trial.*” *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

Summary judgment is appropriate in a trade dress case. *See Disc Golf Ass'n, Inc. v. Champion Discs, Znc.*, 158 F.3d 1002, 1006 (9th Cir. 1998) (summary judgment for defendant granted since no genuine issue of fact as to functionality of trade dress). Summary judgment also is appropriate in a copyright infringement case. *Shaw v. Lindheim*, 919 F.2d 1353, 1359 (9th Cir. 1990); *Celotex Corp. v. Catrett*, 477 U.S. 317, 322-23 (1986); *see also, Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1446 (9th Cir.1994) (Walker, J) (Summary Judgment for defendant granted in case involving appearance of computer icons).

IV. PLAINTIFF CANNOT SUPPORT ITS BURDEN OF PROVING THAT DEFENDANT VIOLATED THE LANHAM ACT.

A. OVERVIEW

Public policy favors free competition. 1 J.T. McCarthy, *McCarthy on Trademarks & Unfair Competition* (hereinafter “___ McCarthy”), § 1:1. Protection from copying is the exception to the rule, not the rule. *Id.* This important public policy protects those like Paragon from others like Plaintiff who seek to monopolize copies of centuries-old public domain designs.

Regarding Plaintiff's Lanham Act and analogous state and common law claims, the Ninth Circuit stated that the "ultimate test" for unfair competition (regardless of label) is the same as for trademark infringement, i.e., whether the public "is likely to be deceived or confused" by the similarity of two parties' goods or services. *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988) (*citing New West Corp v. NYM Co. of Calif., Inc.*, 595 F.2d 1194, 1201 (9th Cir. 1979)); *Cleary v. News Corp.*, 30 F.3d 1255, 1262-63 (9th Cir. 1994).

Regarding Plaintiff's copyright infringement claim, Plaintiff must first prove that more than trivial elements of its designs are sufficiently original, and that Defendant copied those original elements. *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991).

As set out in the discussions below, Plaintiff has no evidence whatsoever to support its allegations that it has protectable rights of any kind in its tile designs, tile displays and tile lines, whether under unfair competition, false advertising or copyright laws.

B. DEFENDANT DID NOT VIOLATE THE LANHAM ACT.

1. Elements of the Claim.

Section 43(a) of the Lanham Act makes actionable the deceptive and misleading use in commerce of "any word, term, name, symbol, or device" on or in connection with any goods. 15 U.S.C. § 1125(a); *Kendall-Jackson Winery, Ltd. v. E&J Gallo Winery*, 150 F.3d 1042, 1046 (9th Cir. 1998). This provision includes trade dress as well as trademarks. *Id.*

Plaintiff's §43(a) claims are based upon the claimed trade dress of its tiles, tile lines and tile displays. Trade dress refers to the ability of a product's appearance (as opposed to its name, manufacturer, or concept) to connote its source. *See Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 582-84 (2d Cir. 1993); *Publications Int'l., Ltd. v. Landoll, Inc.*, 164 F.3d 337, 339, 343 (7th Cir. 1998), *cert. denied*, (US) 119 S. Ct. 1498 (1999). It is comprised of the total image of a product and may include features such as size, shape, color, color combinations, texture or graphics, and even particular sales techniques. *International Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 822 (9th Cir.1993).

Plaintiff has the burden of proof to sufficiently identify the protectable elements of its trade dress. *Yurman, Design, Inc. v. PAJ, Inc.*, 262 F.3d 101, 114 (2d Cir. 2001). It then must prove that its claimed trade dress (1) is non-functional, (2) has acquired secondary meaning, and (3) is likely to be confused with Defendant's tiles, tile lines and tile displays by members of the consuming public. *See Wal-Mart Stores*, 529 U.S. at 209, 211-14; *Two Pesos v. Taco Cabana*, 505 U.S. 763, 769 (1992); *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1257-58 (9th Cir. 2001). Plaintiff's failure to meet any one of these requisite elements defeats its Lanham Act claims in their entirety.

2. Plaintiff Has Failed to Identify Any Protectable Trade Dress

As a threshold matter, before a claim for trade dress infringement can be considered, the allegedly infringed elements of the claimed trade dress must be identified with specificity. *Yurman Design* at 114; *see also, e.g. Big Island Cookies v. Cookie Corner*, 269 F.Supp.2d 1236, 1246 (D. HI 2003) (*citing and applying Yurman*). Plaintiff has identified its alleged trade dresses in nothing more than abstract, ambiguous and general terms that apply to any number of tile

1 designs, tile lines and tile displays manufactured by innumerable manufacturers:

2 [W]alker Zanger's tiles are distinguished by their classical designs and careful
3 craftsmanship, which give the tiles the look of Old World handiwork. The tiles
4 are further distinguished by the depth and dimensions of their design relief, i.e.,
5 the range between the highest and lowest points of the relief, as well as by the
6 level of intricate detailing at all levels of the relief. The tiles are further
7 distinguished by Walker Zanger's use of colors and glazes that enhance the
8 appearance of Old World craftsmanship. Walker Zanger further invokes Old
9 World craftsmanship through its unique approach to designing and marketing
10 tiles, through which Walker Zanger creates collections of tiles designed with a
11 particular theme in mind.

12 **IBD, ¶5, Exh. D** (*Pltf's Resp. to Interrog No. 15* at 30:1-9). At Paragon's Fed.R.Civ.Proc.
13 30(b)(6) deposition of Plaintiff, the witness who was produced specifically to testify regarding
14 Plaintiff's alleged trade dress and the various elements thereof added nothing to clarify matters.
15 For example, regarding the protected elements generally, he stated "I believe the protected
16 elements of the tile line are that the specific designs of each tile and the way that those designs
17 work together to promote a cohesive design package or design vision. . . ." **IBD, ¶3, Exh. B**
18 (*Becker*, 150:5-9). Given many opportunities to clarify its vague identifications of its tiles' trade
19 dress elements, Plaintiff failed. *Id.*, 73:9 to 89:21. To this day Plaintiff has not offered to
20 produce another witness more qualified to respond to those questions and issues. **IBD, ¶19; see,**
21 *Fed.R.Civ.Proc.* 30(b)(6).

22 Likewise, Plaintiff ambiguously states that "Each of [its] product lines is devoted to a
23 particular artistic concept, and incorporates coordinated tile pieces that, used in combination,
24 evoke that concept." **IBD, ¶5, Exh. D** (*Pltf's Resp. to Interrog. No. 16* at 31:5-7). Its Avignon
25 line "uses carefully crafted, classically inspired designs and colors to create a French Provençal
26 theme" and its Newport line "uses whimsical, seashore-related designs and colors to create a
27 light, beachfront theme." *Id.*, 31:7-10. The lines were coordinated to "evoke a particular theme,
28 and the particular designs and colors used in the Avignon and Newport product lines[] are
distinctive aspects that the consuming public associates with Walker Zanger" *Id.*, 31:10-13.

Plaintiff's evasive responses to direct questioning that would have permitted better
identifications did nothing to help Plaintiff. **IBD, ¶3, Exh. B** (*Becker*, 89:22 *ff.*)

Plaintiff's description of the protectable elements of its tile displays' trade dress is no less

1 abstract, ambiguous and overly general:

2 Walker Zanger pioneered the use of three types of tile displays In its built-in
3 vignettes, Walker Zanger builds a full-size model of a portion of a home – a
4 corner of a bathroom . . . or a wall of a kitchen, complete with fixtures – and uses
5 that model to demonstrate how its tiles may be used in a real life setting.
6 [Plaintiff's] concept boards are a smaller-scale, portable version of the same idea
7 – [Plaintiff] recreates on a board a section of a kitchen backsplash . . . fully
8 grouted, to demonstrate how its coordinated tiles may be used to achieve a
9 particular effect. [Plaintiff's] library boards [demonstrate] the concept-oriented
10 product lines that are unique to it [including] samples of the tiles that make up a
11 particular product line. [It] is decorated with complementary colors and designs,
12 and includes a narrative describing the design concept of the particular line.

13 **IBD, ¶5, Exh. D** (*Pltf's Resp. to Interrog. No.17* at 32:7-19). It added that “all feature Walker
14 Zanger's logo.” *Id.*, 32:19.

15 Analyzing the elements of the trade dress of Plaintiff's tile displays is unnecessary,
16 however, because Plaintiff has absolutely no evidence that Paragon has utilized even a single
17 stated element, much less the entire look and feel as described.

18 The concept of “trade dress” is not so pliable that it can be stretched to give exclusive
19 rights to such vague and abstract images or marketing themes as these. *Yurman Design*, 262 F.3d
20 at 114; 1 *McCarthy*, §§ 8:3, 8:5.1, 8:6. Extending protection without clear articulation would
21 hamper efforts to market competitive goods. *Yurman* at 114 (quoting *Landscape Forms, Inc. v.*
22 *Columbia Cascade Co.*, 113 F.3d 373, 380 (2d. Cir. 1997)).

23 All of the cases that have addressed the issue have held that descriptions such as
24 Plaintiff's are insufficient to establish an identifiable trade dress. For example, *Yurman*
25 described its jewelry line's trade dress in terms of an “overall impression.” 262 F.3d at 114. It
26 stated that its jewelry had “a structural, almost industrial motif of twisted multi-strand cable,
27 executed with a polished and elegant finish, and set off by gemstones.” *Id.* The court rejected
28 this “overall impression” theory stating that *Yurman* “never identified the elements that make up
its trade dress... [requiring] dismissal of the Lanham Act claim as a matter of law.” *Id.*

Similarly, in *Landscape Forms*, the Second Circuit held that “a plaintiff's inability to
explain . . . exactly which aspects of its product design(s) merit protection may indicate that . . .
claimant seeks protection for an unprotectable style, theme or idea.” 113 F.3d at 380. The
descriptions of the furniture line elements included descriptions much like Plaintiff's

1 descriptions. *Id.*, 381-82. In that case, the court admonished that “these and the many other
 2 similarly laudatory descriptions fail to indicate what makes the furniture line distinctive and
 3 perceived as coming from a single source. *Id.* at 382. It then noted that, “Tellingly, the more
 4 detailed parts of the above descriptions apply to some, but not all, of the ten items in the [line].”
 5 *Id.*

6 In *Central Tools, Inc. v. Products Engineering Corp.*, the court required the “discrete
 7 elements” of the trade dress to be separated out in a list so that it could “coherently define
 8 exactly what the trade dress consists of. 936 F.Supp. 58, 65 (D.R.I 1996), *citing* 1 *McCarthy* §
 9 8.01[1][c]. Because the plaintiff “designed its arguments to cast its trade dress over every dial
 10 indicator set it makes,” the court refused to conduct a Lanham Act inquiry over an entire line,
 11 limiting the inquiry instead to three products for which the plaintiff met the court’s test in
 12 individual detail. *Id.* at 65-66. Here, Plaintiff’s descriptions are no more specific or less
 13 laudatory than any of the above.

14 Plaintiff itself admits that it is not the only company that has “coordinated tile pieces”
 15 that are “devoted to a particular artistic concept” that when “used in combination, evoke that
 16 concept.” **IBD**, ¶2,3,10: **Exhs. A** (*Petrocelli*, 64:1-13), **B** (*Becker*, 92:14-25, 93:1) and **I**
 17 (*Leiferman*, 38:3-12). Numerous tile companies were identified by name, and at least eight have
 18 been identified by name as having either a French Provençal tile line or a tile line with a French
 19 feel. **Exh. I** (*Leiferman*, 38:3-12) and **G** (*Reed*, 37:9-12; 38).

20 Plaintiff’s stated individual elements do nothing to identify the protectable trade dress
 21 elements that allegedly act as source identifiers. For example, the “depth of relief” that Plaintiff
 22 claims is nowhere defined or distinguished despite express invitations to do so. *See e.g.* **Exh. B**
 23 (*Becker*, 76:21-25; 77:1-2). All that was said was “The thing that is most unique about the depth
 24 and dimension of the design relief is that they are elements that are used in creating specific and
 25 unique designs.” *Id.* Similarly, while Plaintiff claims that the colors used in their tiles are
 26 unique, it does not describe or define the specific colors, it does not offer any evidence that its
 27 use of the colors is exclusive, and it provides no evidence that Paragon uses those colors. *See*
 28 *e.g. Id.* at 84:6-11.

Moreover, while Plaintiff claims a monopoly on tiles that evoke French Provençal motifs,” it does nothing to indicate or specify what it is about those colors and motifs that may be its protectable trade dress. For example, when asked to describe the trade dress of Plaintiff’s Romanesque tile, Becker replied: “What it is about their tile...is the fact that this tile is a part of a collection that is recognized to be a Walker Zanger product.” *Id.* at 38: 22-25; 39: 1-7.

Hence, it is impossible for another manufacturer to identify Plaintiff’s alleged trade dress in any meaningful way so that it could avoid infringing it. *See Wal-Mart Stores*, 529 U.S. at 215. Instead, Plaintiff would have the Court extend trade dress protection to its tiles for the most abstract, ambiguous, metaphysical aspects that define characteristics common to virtually all manufacturers of decorative ceramic tiles. *See Yurman*, 262 F.3d at 114.

The futility of Plaintiff’s identification claims is exemplified by its own witnesses, who have identified tiles and tile lines from other manufacturers that fit the same overall description. *See e.g. IBD*, ¶3,8, 10, **Exhs. B** (Becker, 74:22-24; 75:8-18; 76:4-6; 85:18-19&25; 86:1-3; 89:3-11; 90:19-25; 91:1-2; 92:14-25; 93:1), **G** (*Reed*, 37:9-12; 38), and **I** (*Leiferman*, 38:3-12).

For all of the above reasons, Plaintiff cannot assert trade dress protection for the claimed elements of its tile lines, either. *See, Landscape Forms*, 113 F.3d at 381 (“If the law protected style at such a level of abstraction, Braque might have prevented Picasso from selling cubist paintings in the United States.”).

And for all of the same reasons, Plaintiff cannot obtain trade dress protection for its tile displays. Plaintiff has shown nothing to establish that its tile displays either do not simply reflect industry wide practices or that any unique and protectable element of its displays are exclusive to itself and copied by Plaintiff. *IBD*, ¶2, **Exh. B** (*Becker*, 152:1-6; 160:1-12).

3. Plaintiff’s Tile Designs Are Functional.

Plaintiff bears the burden of proving nonfunctionality. 15 U.S.C. § 1125(a)(3); *Sega Enterprises Ltd., v. Accolade, Inc.*, 977 F.2d 1510, 1530-31 (9th Cir.1992). Plaintiff has failed to produce evidence sufficient under Section 43(a) of the Lanham Act to support that burden of proof at trial. *See also, TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 32 (2001); *Rachel v. Banana Republic inc.*, 831 F.3d 1503, 1506 (9th Cir. 1987).

1 The Ninth Circuit's four part test for functionality asks (1) whether the design yields a
 2 utilitarian advantage; (2) whether alternative designs are available; (3) whether advertising touts
 3 the utilitarian advantage of the design; and (4) whether the particular design results from a
 4 comparatively simple or inexpensive method of manufacture. *Disc Golf Ass'n, Inc. v. Champion*
 5 *Discs, Inc.*, 158 F.3d 1002, 1006 (9th Cir. 1998); *Clicks Billiards*, 251 F.3d at 1260.

6 Even faithful copying of functional product configuration is not trade dress infringement:

7 Functional features of a product are features which constitute the actual benefit
 8 that the consumer wishes to purchase, as distinguished from an assurance that a
 9 particular entity made, sponsored, or endorsed a product. For an overall product
 10 configuration to be recognized as a trademark, the entire design must be
 nonfunctional. The right to copy better working designs would, in due course, be
 stripped of all meaning if overall functional designs were accorded trademark
 protection because they included a few arbitrary and nonfunctional features.

11 *Leatherman Tool Group, Inc. v. Cooper Industries, Inc.*, 199 F.3d 1009, 1012 (9th Cir. 1999); *see*
 12 *also, Wal-Mart* at 213 (quoted in pertinent part on page 1, above), and at n.12 ("Consumers
 13 should not be deprived of the benefits of competition with regard to the utilitarian and esthetic
 14 purposes that product design ordinarily serves."). Thus, "a product feature whose impact is only
 15 'decorative and aesthetic, with no source identifying role, cannot be given exclusive rights under
 16 trade dress law. *Clicks Billiards*, 251 F.3d at 1258; *see also, Seed Lighting Design Co. v. Home*
 17 *Depot*, 2005 WL 1868152 at *5 (N.D. CA 2005).

18 Plaintiff has completely insufficient evidence to satisfy these standards.

19 **a) Prong 1: Plaintiff's Tile Designs, Lines and Displays Yield Utilitarian**
 20 **Advantages.**

21 Trade dress is functional if it is "essential to the use or purpose of the article and it affects
 22 the cost or quality of the article." *Leatherman Tool Group*, 199 F.3d at 1012. Even if a product
 23 feature is purely ornamental and otherwise serves no utilitarian purpose, it is essential to the use
 24 or purpose of the product if it attracts consumers to buy the product instead of identifying the
 25 source of the product. *Id.*; *see also, Fabrica, Inc. v. El Dorado Corp.*, 697 F.3d 890, 894-95 (9th
 26 Cir. 1993); *Schwinn Bicycle Co. v. Diversified Products Corp.*, 740 F.Supp. 517, 520-21 (N.D.
 27 IL 1990) (exercise bicycle with wheel in front found functional because the public found it more
 28 attractive that way).

1 Plaintiff's tile designs are aesthetically functional. Plaintiffs' witnesses unanimously
 2 testify that their customers exclusively select Plaintiffs' products for their aesthetic benefits. One
 3 executive testified that the customers that he had sold tile to purchased the tiles for purely
 4 aesthetic reasons. **IBD, ¶3, Exh. B** (*Becker*, 166:17-21). Another testified that "our customers
 5 purchase our tile for the quality and the aesthetics." *Id.* ¶14, **Exh. M** (*Wright*, 60:6-7). The
 6 owner of an interior design firm agreed, testifying that "the majority of the time," a designer
 7 recommends a tile to the customer because of the way the tile looks, not based upon the
 8 manufacturer of the tile. *Id.* ¶10, **Exh. I** (*Leiferman*, 93:20-24; 94:1-6). An executive from a
 9 design center also chooses Plaintiff's tiles based upon the aesthetic appeal of the designs. *Id.* ¶8,
 10 **Exh. G** (*Reed*, 13: 17-21; 31:2-11). Finally, one customer surveyed by Dr. Osper's secondary
 11 meaning survey of consumers remarked, "Ceramic tiles do not have a brand name recognition –
 12 you go to the tile store and select what fits and is on display." **IBD, ¶21, Exh. S** (Consumer
 13 Survey).

14 In *Wallace International Silversmiths, Inc. v Godinger Silver Art Co., Inc.*, the Second
 15 Circuit held that the plaintiff's "Grande Baroque" silver pattern was not a trademark, but rather
 16 one design among many used by the plaintiff. 916 F.2d 76, 80 (2nd Cir, 1990), *cert denied*, 499
 17 U.S. 976 (1991) (*abrogation on other grounds recognized by Ashley Furniture Indus., Inc. v.*
 18 *SanGiacomo N.A.*, 187 F.3d 363, 372 (4th Cir.1999)). Like Plaintiff, *Wallace Int'l* was known
 19 for the quality of its product, and, as in this case, testimony was presented that anyone
 20 knowledgeable about the product could identify the plaintiff's pattern from those of competitors.
 21 *Id.* at 79-80.

22 While acknowledging the similarities between the plaintiff's and the defendant's patterns,
 23 the Second Circuit found that the typical elements of Baroque style -- curls, roots, and flowers --
 24 were needed to compete in the silverware market because the style was popular. *Id.* at 79-80.
 25 Therefore, the defendant prevailed because aesthetic functionality of the design or ornamentation
 26 acts as a complete bar to trademark protection. *Id.* at 80-81; *see also, I.P. Lund Trading ApS v.*
 27 *Kohler Co.*, 118 F.Supp.2d 92 (D.MA 2000) ("Primary significance" of faucet design was
 28 aesthetic, not source identifying).

1 Plaintiff is no different, as it proudly proclaims that its claimed trade dress elements are
 2 the necessary result of the high quality nature of the manufacturing process. **IBD, ¶3, Exh. B**
 3 (*Becker*, 35:22 to 36:1, 71:14-25).

4 **b) Prong 3: Plaintiff's Website, Advertising, Marketing, Witnesses**
 5 **and Copyright Tout the Trade Dress' Utilitarian Advantages.**

6 Plaintiff's own evidence proves that its claimed trade dress is functional. *See DCNL Inc. v.*
 7 *Almar Sales Co.*, 47 U.S.P.Q.2d 1406, 1414 (N.D. Cal. 1997), *aff'd without opinion*, 178 F.3d
 8 1308 (9th Cir. 1998) (no secondary meaning in advertisements that focus on functional features).
 9 Of more than 4,300 consisting entirely of articles, press clippings and advertisements, the
 10 handful of relevant pages all exclusively tout aesthetic utility. *See, e.g., IBD, ¶12, Exh. K*
 11 (*WZ00374 -75, WZ00653-57, WZ01426-28, WZ01773, WZ02966-68*). Of all of those
 12 documents, only around 147 (less than .03%) contain articles that mention the pertinent tiles or
 13 tile lines. *Trang Decl.*, ¶5. Of the 147 documents, only 4 mention the Romanesque tile by
 14 name, and then only as a picture caption. *Id.*, ¶ 6. Even the article in the February 15, 2000
 15 issue of "Tile & Decorative Surfaces" magazine that introduced the Avignon line described the
 16 line in purely laudatory, aesthetic terms like "exquisitely carved Romanesque Gothic and
 17 Baroque designs" offered "in two glaze treatments that reveal "the details of the bisque
 18 underneath" and provide "a deeper, more jewel-like finish." **IBD, ¶12, Exh. K** (*WZ00378*).
 19 Nothing indicates that any of these features are exclusive to Plaintiff or intended to designate
 20 Plaintiff as the source. *Id.*, ¶2, **Exh. B** (*Petrocelli*, 51:20-60, 63-64:13).
 21 Similarly, the *only* article of substance about the Newport line also focuses exclusively on the
 22 tiles' aesthetic function without a single indication that any of the features are exclusive. *Id.*, *Id.*
 23 **¶12, Exh. K** (*WZ01773*). Plaintiff itself proudly emphasizes the practical and aesthetic utility of
 24 the tiles' appearance to the virtual exclusion of any source identifying nature. *Id.* **¶3, Exh. B**
 25 (*Becker*, 35:22-25, 36:1, 71:14-25, 112:18-25).

26 Lastly, Plaintiff's attempt to copyright all five tile designs is evidence that it recognizes
 27 an aesthetic utility to each of the designs, and that the tiles were created to provide consumers
 28 with aesthetically pleasing choices for the design of their kitchens and baths. *See TrafFix*

1 *Devices*, 532 U.S. at 32.

2 **4. Plaintiff Has Failed To Establish Secondary Meaning**

3 Since its Lanham Act claims involve product design trade dress, Plaintiff bears the
4 burden of proving that its claimed trade dress has acquired trademark status in the minds of the
5 consuming public. *Wal-Mart*, 529 U.S. at 215-16. A plaintiff's trade dress acquires secondary
6 meaning when the purchasing public associates the dress with a particular source. *Fuddruckers*
7 *Inc. v. Doc's B.R. Others, Inc.*, 826 F. 2d 837, 843 (1987).

8 Proving secondary meaning generally "entails vigorous evidentiary requirements." *Perini*
9 *Corp. v. Perini Constr.*, 915 F.2d 121, 125 (4th Cir. 1990). Such evidence may be direct or
10 circumstantial. *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC (Yankee Candle)* 259
11 F.3d 25, 43-44 (2nd Cir. 2001). Plaintiff has neither.

12 **a) Plaintiff Has No Direct Evidence of Secondary Meaning.**

13 Plaintiff's direct evidence of secondary meaning, such that it is, cannot address its burden
14 of proof. As the First Circuit recognized, "The only direct evidence probative of secondary
15 meaning is consumer surveys and testimony by individual consumers." *Yankee Candle*, 259
16 F.3d at 43 (citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42 (1st Cir.,1998)); *see also*,
17 *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir.1989); *Seed Lighting Design*,
18 2005 WL 1868152, *5. Although survey evidence is not required, "an expert survey of
19 *purchasers* can provide the most persuasive evidence of secondary meaning." *Vision Sports*, 888
20 F.2d at 615 (emphasis added).

21 Plaintiff has no consumer testimonials. **IBD, ¶2, Exh. A** (*Petrocelli*, 96:9-25). Plaintiff's
22 witnesses state that customers would not know the tiles' source without a label. *Id.*, ¶8, 10, **Exh.**
23 **G** (*Reed*, 86:11-25; 87:2-23) and **I** (*Leiferman Depo.* 41: 35; 42: 1-4).

24 Plaintiff's secondary meaning survey that it designated for use at trial is ill conceived and
25 designed. This survey, of interior designers only, was conducted on October 14 - 24 and
26 November 4 - 10, 2005.³ **IBD, ¶15, Exh. N** (Dr. Osberg's Survey to Determine Extent to which
27

28 ³ The survey was conducted in two parts, the first part of fewer than half of the respondents was conducted in six

Walker & Zanger Ceramic Tiles Have Acquired Secondary Meaning (If At All) Among Interior Designers (hereinafter, “Oster Survey”)). It is so riddled with problems that it is should be inadmissible. *Clicks Billiards*, 251 F.3d at 1262; *see also*, *Paragon’s Motion to Strike Survey* filed concurrently herewith. Plaintiff’s secondary meaning survey is inadmissible because Paragon says its customers include interior designers, builders, design centers, architects, contractors and end users (i.e., home owners or purchasers and retail customers). **IBD**, ¶2,10,14, **Exhs. A** (*Petrocelli*, 91:15-25), **I** (*Leiferman*, 100: 2- 25; 101:9-15) and **M** (*Wright*, 8:23-25; 9:1-2). Yet interior designers are surveyed to the exclusion of all others. **IBD**, ¶15, **Exh. N** (Osberg Survey).

Thus, Plaintiff’s survey is fatally flawed, under-inclusive, it consists of the hand picked universe that it admits is the one class of “customers” sophisticated enough to identify the product without suffering confusion. *See IBD*, ¶3,8,10, **Exhs. B** (*Becker*, 136:12-18; 141:20-25; 142:1-9) (disqualifying designers as retail or average customers because they are a special segment of customers with specialized knowledge and are “much more likely to recognize specific elements in tiles as unique to” Plaintiff.), **G** (*Reed*, 33: 2-6) and **I** (*Leiferman*, 71:8-25; 72: 8-14) (only designers who had prior experience with the tiles or who “knew the line well” have been able to identify Plaintiff’s tiles by simply viewing them). Using such specialists is clearly improper. *Vision Sports*, *supra*, 888 F.2d at 615.

b) Plaintiff Has No Circumstantial Evidence of Secondary Meaning

Circumstantial evidence of secondary meaning includes evidence of (1) the length and exclusivity of use of the trade dress; (2) the nature and extent of advertising and promotion of the trade dress (3) the existence of substantial advertising; (4) the product's established place in the market; (5) proof of intentional copying; and (6) “look for” promotion that specifically directs a consumer's attention to those features claimed as trade dress. *Yankee Candle*, 259 F.3d at 43-44.

i. Plaintiff’s Tiles, Tile Lines and Tile Displays Had Not Been In

markets where Plaintiff and Defendant compete. The second part was conducted in markets where they do not compete. **IBD Decl.**, ¶20, **Exh. R** (*Cogan Decl.*, pp. 3-6)

Existence Long Enough to Acquire Secondary Meaning.

Plaintiff must prove that its claimed trade dress had secondary meaning when Paragon first chose its tile designs. *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 802 (9th Cir. 1970). Plaintiff's survey was conducted more than three years after Paragon first conceptualized its Bellissima line and nearly two years after Plaintiff learned of Paragon's tiles. **IBD, ¶7, Exh. F** (*Bedrosian*, 91:19-21, 93:21-25, 95:1&12-25, 96:1&8-18). The two to three years from the introduction of the tiles to the time Paragon allegedly first used them is insufficient time for a product design to insinuate itself into the minds of the general public as a source identifier. *See* Lanham Act § 2(f), 15 U.S.C.A. § 1052(f); *Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 789-90 (8th Cir. 1995). The fame of Plaintiff's tiles as measured today cannot possibly evidence the fame of its tiles as measured only two to three years after they were first introduced, before the bulk of its advertising took place. *See, Trang, ¶4-7, Exh. A.*

ii. Plaintiff's Advertising Does Not Promote Plaintiff's Claimed Trade Dress as a Source Identifier and Its Source Identifying Advertising Expenditures Are Nonexistent

Extensive advertising promoting utilitarian advantages without calling attention to the alleged non-utilitarian design does not evidence secondary meaning. *Yankee Candle*, 259 F.3d at 44; *Brooks Shoe Mfg. Co. v. Suave Shoe Co.*, 716 F.2d 854, 860 (11th Cir. 1983); *Continental Laboratory Products, Inc. v. Medax Intern., Inc.*, 114 F.Supp.2d 992, 1000 (S.D. Cal. 2000).

Plaintiff has not produced a single example of advertising that does anything more than picture the product or mention it generally in the text of an article. *Trang, ¶4-7, Exh. A.* In fact, less than 0.01% of the documents produced by Plaintiff mention the allegedly infringed tiles or tile lines by name, and less than 0.02% show any of the allegedly infringed tiles, and none show a single allegedly infringed tile display. *Id.*

Plaintiff has not produced any evidence of any advertising expenditures directed at establishing secondary meaning. *Brooks Shoe Mfg. Co. v. Suave Shoe Corp.*, 716 F.2d 854, 860 (11th Cir. 1983). *See, In re Redken Laboratories, Inc.*, 170 U.S.P.Q. 526, 529 (T.T.A.B. 1971). Plaintiff points to "millions" of dollars spent on advertising, however, the court has been clear that a "large expenditure of money does not in itself create legally protectable rights." *Carter-*

1 *Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 800 (9th Cir.1970). To serve as evidence
 2 of secondary meaning, the expenditures must be for advertising of the type and nature that will
 3 create secondary meaning. *Brooks*, 716 F.2d at 860; *In re Swift & Co.*, 223 F.2d 950, 954
 4 (C.C.P.A. 1955).

5 No matter how many millions of dollars were spent by Plaintiff on advertising over the
 6 past five years, the evidence shows that little, if any was devoted to the pertinent tiles and tile
 7 lines in any way. **IBD, ¶2, Exh. A** (*Petrocelli*, 76:7-25; 77:1-10); *Trang Decl.*, ¶5-8, **Exh. A**;
 8 *See, In re Kwik Lok Corporation*, 217 U.S.P.Q. (BNA) 1245, 1247-48 (T.T.A.B. 1983).

9 **iii. Plaintiff Has No Evidence of its Products' Market Placement.**

10 Plaintiff has absolutely no evidence of its products' market placement. **IBD, ¶2, Exh. A**
 11 (*Petrocelli*, 39:21-23; 41: 11-18). It only acknowledges that it is but one of many who market
 12 high-end, luxury tiles. *Id.*

13 **iv. Plaintiff Has No Proof of Intentional Copying.**

14 Mere evidence of copying is not at all probative of secondary meaning unless it is
 15 accompanied by "an intentional attempt to capitalize on a company's reputation or goodwill,"
 16 i.e., "to pass off one's goods as those of another." *Seed Lighting*, 2005 WL 1868152 at *10,
 17 citing *Fuddruckers*, 826 F.2d at 844 and *Yankee Candle*, 259 F.3d at 45. There cannot be a *per*
 18 *se* rule because "copying wholly functional features that [are perceived] as lacking any
 19 secondary meaning because of those features' intrinsic economic benefits" may be completely
 20 legitimate. *Id.* at 844, n.9.

21 Assuming, *arguendo*, that Defendant copied Plaintiff's tiles, there is no evidence that it
 22 did so with such intent.⁴ Plaintiff has no evidence that Paragon represented that it was associated
 23 with or sold its tiles under Plaintiff's name or that Paragon suggested that Plaintiff was the
 24 source of its tiles. **IBD, ¶2, Exh. A** (*Petrocelli*, 92:17-25). To the contrary, Plaintiff only has
 25 evidence that Defendant honestly expressed the source of its tiles. *Id.*, ¶13, **Exh. L** (*Foster*,

26
 27 ⁴ Even if there were evidence of intent to deceive, it would not shift the burden of proof to Defendant. *Fuddruckers*
 28 826 F.2d at 844.

73:13-16; 99:21-25; 100: 1-2). Most importantly, Plaintiff can only show the copying of an aesthetically functional design for purchasers to adopt into their decors. **IBD**, ¶7, **Exh. F** (*Bedrosian*, 91:19-21; 93:21-25; 95:1, 12-25; 96:1, 8-18; 282:6-21).

v. Plaintiff Has No “Look For” Promotions

Advertising that merely pictures a product shape and fails to draw attention to its features as a source identifier infers that there is no trademark status. *Yankee Candle*, 259 F.3d at 44. Instead, a party trying to prove secondary meaning must present “look for” advertising. *Int’l Jensen*, 4 F.3d at 824; *see also, Marc Bric Display Corp. v. Joseph Struhl Co., Inc.*, 2003 WL 21696318 at *11 (D.RI 2003); 1 *McCarthy*, § 7:30. Plaintiff has no such advertising. *Trang Decl.*, ¶¶ 4-7 & 8; *see also, IBD*, ¶2, **Exhs. A** (*Petrocelli*, 51:24;52– 60, 63) and **Exh. M**. When specifically asked to do so, Plaintiff could not identify even a single sentence in its discovery that it contends supports its allegations of secondary meaning. **IBD**, ¶2,5, **Exhs. A** (*Petrocelli*, 51:24;52– 60, 63) and **D** (*Pltf’s Resp. to Interrogs.* 30-32).

This lack of “look for” advertising evidences only that Plaintiff’s alleged infringed trade dress has not acquired secondary meaning. *First Brands Corp. v. Fred Meyer, Inc.*, 809 F.2d 1378, 1383 (9th Cir. 1987); *Kykes Laboratory, Inc. v. Calvin*, 610 F.Supp 849, 862 (C.D. Cal. 1985); *DCNL*, 47 U.S.P.Q.2d at 1414.

5. Plaintiff Has Failed To Establish Likelihood Of Confusion

In *Two Pesos Inc.*, the Supreme Court held that “the ultimate test” under §43(a) is whether the public is likely to be deceived or confused by the similarity of the marks.” 505 U.S. at 780 (citations omitted). The “likelihood of confusion” must be as to source or sponsorship, and not merely confusion between the goods themselves. *Fuddruckers*, 826 F.2d at 845.

In the 9th Circuit, likelihood of confusion for trade dress is determined by considering “evidence of actual confusion, the defendant’s intent in adopting the mark, similarity of marks, similarity of goods and marketing channels, and the strength of the mark” (*Id.* at 845), and the degree of care and sophistication of customers. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (1979). The list is not exhaustive, no one factor is dispositive, and the factors must be balanced and considered together in light of the circumstances. *Id.*, 347-48. Plaintiff cannot produce

1 evidence that favors a balance that support its claims.

2 **a) There is No Evidence of Actual Confusion**

3 Evidence of actual confusion is considered persuasive proof that future confusion is
4 likely. *AMF, Inc.*, 599 F.2d at 352. Yet Plaintiff has not produced a scintilla of evidence of
5 actual confusion. **IBD**, ¶2-4, **Exhs. A** (*Petrocelli*, 92:17-25), **B** (*Becker*, 154:7-25, 155:1-15) and
6 **C** (*Bastone*, 12:14-25, 13:1-3).

7 There is no evidence that Defendant misrepresented the source or affiliation of its or
8 Plaintiff's tiles, used a photograph of Plaintiff's product to advertise or promote its own product,
9 or used Plaintiff's name or logo to sell its products. *Id.*, ¶2-4, **Exhs. A** (*Petrocelli*, 92:17-25) and
10 **B** (*Becker*, 154:7-25, 155:1-15); *see, Smith v. Montoro*, 648 F.2d 602, 604 (9th Cir. 1980).

11 Two of Plaintiff's executive employees who are uniquely situated to get reports of
12 confusion testified that they knew of none. **IBD**, ¶4, 14, **Exhs. C** (*Bastone*, 12:14-25, 13:1-3)
13 and **M** (*Wright*, 68:12 - 70:6). One, the director of builder sales, identified at least ten design
14 centers that display Plaintiff's and Defendant's tiles in identical manners within close proximity
15 to one other, without indication of origin. *Id.*, **Exh. M** (*Wright*, 68:12 - 70:6). Nevertheless, no
16 one ever reported confusion of any kind to her. *Id.*, 76:18 – 78:8.

17 Plaintiff's private investigator also testified that he never believed the tiles that
18 Defendant's salespersons were showing him were manufactured by Plaintiff. **IBD**, ¶13, **Exh. L**
19 (*Foster*, 151:21-23). Moreover, he reported no one represented in any way that Defendant's tiles
20 were manufactured by or affiliated with Plaintiff, and no one indicated confusion. *Id.* at 153:7-
21 13; 154:1-7. His report only shows that everyone knew the differences between the tiles and the
22 true source of the tiles. *Id.* at 73:13-16; 99:21-25; 100:1-2.

23 Defendant's third party witnesses also testified that there was no confusion. In all the
24 years that one had been selling Defendant's Bellissima line, no one has expressed confusion
25 between the products or their sources. **IBD**, ¶8, **Exh. G** (*Reed*⁵, 33:8 - 34:8). Another testified

26 _____
27 ⁵ Reed is Vice President of On-Site Design, a prominent the design center. She is responsible for managing the
28 design center locations and making purchasing decisions for materials that they have inside the design center. **IBD**
Decl. ¶10, *Ex. I: Reed*, 11: 4-6.

1 that she had not been confused and that no one ever expressed confusion to her. *Id.*, ¶10, **Exh. I**
 2 (*Leiferman*, 43:13-47, 15, 90:6-17).

3 Defendant's survey of consumers for likelihood of confusion only proves that there is
 4 none. Of 211 consumers surveyed in six states and nine cities in which the parties compete, not
 5 one mentioned Walker Zanger by name. **IBD**, ¶20, **Exh. R** (Cogen Suppl. Decl., ¶58).
 6 Moreover, Dr. Osterman's survey clearly reveals that an insignificant level of confusion existed.
 7 *Id.*, ¶20, **Exh. R** (Cogen Suppl. Decl., ¶98); *see*, .

8 **b) Defendant Did Not Copy Any Trade Dress With the Intent to Deceive**

9 For the reasons set forth in subsection (IV.B.4.b.iv.) above, Plaintiff has no evidence that
 10 Defendant copied its claimed trade dress with the intent to trade on Plaintiff's good will or to
 11 deceive the public.

12 **c) Any Similarity To the Alleged Trade Dress is Irrelevant**

13 Even if Plaintiff can show that the entirety of the elements constitute protectable trade
 14 dress, it has presented absolutely no evidence that Paragon has copied all of those elements. *See*
 15 *Schwinn Bicycle Co.*, 740 F.Supp at 520; *AmBrit Inc. v Kraft Inc.*, 812 F.2d 1531, 1537 (11th Cir
 16 Fla 1986); *Falcon Rice Mill Inc. v Community Rice Mill Inc.*, 725 F2d 336, 346 (5th Cir La
 17 1984).

18 **d) The Products and Marketing Channels Are Different**

19 Although both products are ceramic tiles, every one of Plaintiff's witnesses distinguishes
 20 between a market for handmade, high-end tiles and a market for less expensive, machine made
 21 tiles. **IBD** ¶2,4,10,14, **Exhs. B** (*Petrocelli Depo.* 39:21-23; 41:11-18), **C** (*Becker*, 46:5-10) **D**
 22 (*Bastone*, 21:16-17, 18:6-7; 19:17-19), **K** (*Leiferman*, 29:18-25, 30:6-7) and **O** (*Wright Depo.*,
 23 58: 23-25; 67). The parties target different customers)*Id.*, ¶7,8, 10, 14, **Exh. F** (*Bedrosian*,
 24 92:17-25, 231:4-6), **Exh. G** (*Reed*, 20:9-25 & 21:1-5, 9-12, 26:20-25, 27: 1); **Exh. I** (*Leiferman*,
 25 30); and **M** (*Wright*, 8:23-25; 9:1-2)), and they market and advertise in completely different
 26 ways. *Id.*, ¶ 2, 4, 5: **Exhs. A** (*Petrocelli*, 103:17-25, 104:1-12, 109:12-25); **C** (*Bastone*, 8:15-21,
 27 21:16-17, 23:3-5); **D** (*Resp. to Interrog Resp. No. 15*) and **I** (*Reed*, 20:9-25 & 21:1-5, 9-12,
 28 26:20-25, 27: 1). Accordingly, Plaintiff cannot carry this element, either.

C. PARAGON DID NOT COMMIT FALSE ADVERTISING

The elements of a false advertising claim under Section 43(a) are: (1) a false statement of fact by the defendant in a commercial advertisement about its own or another's product; (2) the statement actually deceived or has the tendency to deceive a substantial segment of its audience; (3) the deception is material, in that it is likely to influence the purchasing decision; (4) the defendant caused its false statement to enter interstate commerce; and (5) the plaintiff has been or is likely to be injured as a result of the false statement, either by direct diversion of sales from itself to defendant or by a lessening of the goodwill associated with its products. *Southland Sod Farms* at 1139. Plaintiff has not produced any evidence to support any one of these elements.

D. PLAINTIFF'S STATE AND COMMON LAW ACTIONS MUST FAIL

The Ninth Circuit has consistently held that all unfair competition and false advertising claims, whether under the Lanham Act, state, or common law, all stand and fall together. *Cleary*, 30 F.3d at 1262-63 (citations omitted). Accordingly, for all of the reasons set out in sections A to C, above, Plaintiff's state and common law claims fail.

E. DEFENDANT DID NOT COMMIT COPYRIGHT INFRINGEMENT

In order to establish infringement, Plaintiff must prove: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original. *Feist Publ'ns*, 499 U.S. at 361.

Plaintiff's copyright certificates are *prima facie* evidence of these requirements. 17 U.S.C. § 409(c). However, they do not create a presumption that Plaintiff did not copy the designs of those tiles. *Smith v. Jackson*, 84 F.3d 1213, 1219 (9th Cir. 1996).

The evidentiary weight to be given the copyright certificates is within the court's discretion. *Id.* Section 409(c) presumptions may be rebutted easily with any evidence that will raise a question as to whether Plaintiff's design was based on another. *Durham Industries. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1986); *North Coast Industries v. Jason Maxwell, Inc.*, 972 F.2d 1031, 1033 (9th Cir. 1992); *Entertainment Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1218 (9th Cir. 1997).

1 **1. Prong 1: Plaintiff's Copyright Certificates Are Not Valid**

2 A material misrepresentation on a copyright certificate application is grounds to
 3 invalidate the certificate. *See, Lennon v. Seaman*, 84 F.Supp.2d 522, 525-26 (S.D.NY, 2000)
 4 ("Establishing that the certificate was obtained through fraud" overcomes the presumption of
 5 validity. (citations omitted)). As the following subsection sets out, Plaintiff's copyright
 6 certificates contain material misrepresentations. However, since Plaintiff does not carry the
 7 burden of proving that its statements are not fraudulent, Paragon will focus its attention on the
 8 second prong in the next subsection.

9 **2. Prong 2: Plaintiff's Tile Designs Lack the Required Originality**

10 A copyright is invalid if the work it applies to is not original or does not contain the
 11 sufficient modicum of originality to satisfy the Copyright Act's requirements. *Feist Publ'ns*, 499
 12 U.S. at 345. ("Original, as the term is used in copyright, means only that the work was
 13 independently created by the author (*as opposed to copied from other works*)" (emphasis
 14 added)). Where the work is based upon prior existing work, as here, the work must have
 15 "distinguishable variation" that is not merely trivial. *Midway Mfg. Co. v. Bandai-America, Inc.*,
 16 546 F. Supp. 125, 151 (D.N.J. 1982); *Durham Industries, supra*. "The extent to which a
 17 copyrighted work contains protected expression is a matter of law, determined by the court."
 18 *Yankee Candle*, 259 F.3d at 33, n.5.

19 Both of Plaintiff's tile designs are derivatives of preexisting designs. *Complaint, Exh. B*.
 20 A derivative work is one which is substantially copied from a prior work. *Litchfield v. Spielberg*,
 21 736 F.2d 1352, 1357 (9th Cir.1984), *cert. Denied*, 470 U.S. 1052 (1985). The scope of the
 22 copyright in a derivative work covers only the elements contained in the work that are original to
 23 the copyright claimant. *Durham Industries, supra*. Likewise, copyright in a work derived from
 24 a work in the public domain does not extend copyright protection to the public domain work. 17
 25 U.S.C. § 103(b); *Cooling Systems & Flexibles, Inc. v. Stuart Radiator, Inc.*, 777 F.2d 485, 490
 26 (9th Cir. 1985), *overruled on other grounds, Fogerty v. Fantasy, Inc.*, 510 U.S. 517 (1994).

27 There is a plethora of evidence that casts doubt on and completely contradicts Plaintiff's
 28 § 409(c) presumption of originality. For example, Plaintiff's Fed.R.Civ.Proc. 30(b)(6) witness

1 testified that his sole inspiration and evidence of independent and original creation is contained
 2 in 2 pages relating to the two designs. **IBD**, ¶2, 12, **Exh. A**. (*Becker*, 20: 6-19; 23:17-25; 24:1-6;
 3 104: 18-24 and **Exh. K** (WZ4189 and WZ4199).

4 Plaintiff's witness also testified, however, that a particular reference book is in Plaintiff's
 5 vast reference library. *Id.*, 19:15-25; 20:1; 26:17-21. This particular reference book contains
 6 virtually identical images of the very designs that Plaintiff claims it originated. *Id.*, ¶16, **Exh. O**
 7 (*Culwell Decl.*, pp. 4-7, 8, 10). The stark dissimilarities between Plaintiff's tiles and its claimed
 8 "inspirations," and the striking similarities between Plaintiff's tiles and the published precedents
 9 cannot be mere happenstance. *See, also, Id.*, ¶17, **Exh. P** (*Culwell Addendum*, ¶ 2, 5-9, 10, 13).

10 Plaintiff also casts doubt on the validity of its copyright certificates by admitting that
 11 other information on the certificates is not correct. **IBD**, ¶2, **Exh. A** (*Petrocelli*, 126: 12-25;
 12 127:1-3) and **B** (*Becker*, 101:19-25; 102:1; 105:11-17). Additionally, Plaintiff claims its Fleur-
 13 de-Lis tile contains all of the same protectable elements of its Romanesque and Treillage tiles.
 14 *Id.*, ¶E, **Exh. D** (*Pltf's Resp. to Interrog. No. 4*, 14-16). Yet the Fleur-de-Lis design was refused
 15 registration because it lacked the requisite originality. *Id.*, ¶6, **Exh. E** (*Letter* dated February 13,
 16 2004 from John M. Martin, Examiner to Bruce A. Jagger); *see also, Compendium II:*
 17 *Compendium of Copyright Office Practices*⁶ § 503.02(a), (b) and (c) (1984); and 2 Nimmer,
 18 *Nimmer on Copyrights*, § 7.21(A) (The Register has broad discretion to determine what is or is
 19 not copyrightable that will not be reversed unless the decision was "arbitrary, capricious, an
 20 abuse of discretion, or otherwise not in accordance with law.")

21 Lastly, for infringement to occur when the author contributes only small changes to an
 22 unprotectable design or idea, the copying of the original contributions would have to be virtually
 23 identical. *Ets—Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003); *Apple Computer*,
 24 35 F.3d at 1439 ("When the range of protectable expression is narrow, the appropriate standard
 25

26
 27 ⁶ *Compendium II* is used by Copyright Office staff in making registrations and recording documents. See 37 C.F.R.
 28 201.2(b)(7). For the Court's convenience, the cited portions of *Compendium II* are reproduced in Appendix A to
 this brief.

for illicit copying is virtual identity."); *Satava v. Lowry*, 323 F.3d 805, 812 (9th Cir. 2003) ("copyright on these original elements (or their combination) is 'thin,' however, comprising no more than his original contribution to ideas already in the public domain.")

Nothing in Paragon's tiles are "virtually identical copies" of any copyrightable elements in Plaintiff's tiles. The only possible contributions to the public domain acanthus leaf design that Plaintiff can claim involve the height and depth of relief, the twist of the leaves and the generic architectural details above and below the motif. **IBD, ¶3, Exh. B** (*Becker Decl.*, 21:5-25; 22; 23:1-8). Similarly, the only contributions to the public domain image copied for the Treillage design were the unification of the interlocking bands, the raised the relief, and the addition of the generic architectural design at the top of the tile. *Id.* at 107:23 to 108, 112:10-25.

Comparison proves that the only things that may have been copied from Plaintiff's tiles are the unprotectable idea of the three dimensional relief and the unprotectable use of architectural moldings on a decorative wall tile.

In light of all of the above, the record clearly shows that Plaintiff's tile designs are virtually verbatim copies of works that predated Plaintiff's designs by decades, if not centuries. Because the burden has shifted to Plaintiff on all elements of its copyright infringement claims, it has completely failed to present an iota of evidence to prove this essential element, "[rendering] all other facts immaterial." *Celotex*, 477 U.S. at 323.

V. CONCLUSION

In light of all of the above, even taking all inferences in the light most favorable to Plaintiff, Plaintiff has not produced and, indeed, cannot adduce the quantum of evidence it needs to meet its burden. This absence of any evidence supporting Plaintiff's claims warrants summary judgment. Accordingly, Defendant respectfully requests this Court grant the requested relief and grant Summary Judgment dismissing Plaintiff's Complaint in its entirety, with prejudice.

Dated: January 26, 2006

Respectfully submitted,

I Braun Degenshein
Attorney at Law

/s/ I Braun Degenshein

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by: I Braun Degenshein
Attorney for defendant Paragon Industries, Inc.